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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/667,607

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EXAMINER

MOSSER, ROBERT E

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,607	<b>Applicant(s)</b> SUDA ET AL.	
	<b>Examiner</b> ROBERT MOSSER	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-11,14-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-11,14-20, and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/15/2009</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statement entered January 15<sup>th</sup>, 2009 has been considered. A copy of the cited statement(s) including the notation indicating its respective consideration is attached for the Applicant's records.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1-4, 6, 8-11, 18-20, 22, and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Inoue

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(US 6,942,572), in further view of Yoseloff (US 6,311,976) in yet further view of Kaminkow (US 6,837,790).

Claims **1-2, 4, 6, 8, 10-11, 18, 20, 22, and 24**: Bennett teaches a gaming machine comprising:

- a display module for displaying a changing display including the changing of multiple symbols (reel spin feature) at the start of a game (*Bennett* Figure 1, Col 1:60-67);

- a plurality of symbols including a wild symbol (*Bennett* Fig 3, Col 2:12-21);

- multiple win lines comprising a subset of the plurality of symbols (*Bennett* Col 3:25-35);

- a static display of the plurality symbols on multiple areas of the display module (*Bennett* Figure 1, Col 1:60-67); and

- an evaluation module for identifying multiple winning arrangements of symbols and wild symbols on the display such that the wild symbol establishes multiple predefined wins (*Bennett* Figure 1, Col 4:29-5:25).

While Bennett is arguably silent regarding visually differentiating the winning combinations generated on the display, the related invention of Inoue teaches the visual differentiation of winning combinations through the use of different colors of illumination in a gaming machine (*Inoue* Abstract Col 2:5-24, 8:1-11). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the differentiation features of Inoue into the invention of Bennett in order to clearly present

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the winning game results to the player thereby preventing confusion as taught by Inoue (*Inoue* Col 2:5-36)

The combination of Bennett and Inoue is silent regarding the utilization of a time interval to change a wild symbol present in a winning combination to other specific symbols that complete the winning arrangement however the related invention of Yoseloff teaches the morphing (a process understood to inherently include a time interval) of a wild symbol into a specific game symbol as to complete a winning combination (*Yoseloff* Col 8:44-46, 10:21-29, 11:22-37). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the wild symbol morphing features of Yoseloff into the combination of Bennett and Inoue in order to clearly present to the player the specific game symbol that the wild symbol is substituting for.

Though the combination of Bennett, Inoue, and Yoseloff teaches the gaming device as set forth above, the combination is silent regarding the incorporation of a vibration feature such that a display mechanism vibrates when a multiple win feature including a common wild symbol occurs. In a related invention however, Kaminkow teaches the inclusion of a vibration feature in an electronic wager game wherein the feature is further taught by Kaminkow as being readily adaptable to a plurality game trigger events (*Kaminkow* Col 2:16-37, 5:25-32). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the features of the vibration feature as taught by Kaminkow into the invention of Bennett, Inoue, and

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Yoseloff in order to provide the player with additional entertainment and excitement as taught by Kaminkow (*Kaminkow* Col 2:54-60).

Claim **3, 9**, and **19**: In addition to the presentation of Yoseloff as presented above Bennett teaches the sequential displaying of multiple winning arrangements with a changing wild symbol, in which multiple wins are established (*Bennett* Col 4:29-5:25).

Claims **7, 14-17**, and **23** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Bennett (US 6,419,579) in view of Inoue (US 6,942,572), in further view of Yoseloff (US 6,311,976) in yet further view of Kaminkow (US 6,837,790) in still yet further view of Hamano (US 5,205,555).

Though teaching teaches the gaming device as set forth above, the combination of Bennett, Inoue, Yoseloff, and Kaminkow is silent regarding the incorporation of multiplier that are predetermined based on the symbol combination. In a related invention however, Hamano teaches the inclusion of predefined multipliers in a multi-reel slot machine (Figures 15-16, Col 1:38-2:39) to make a slot machine game more entertaining and a more exciting experience. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the predefined multiplier of Hamano into the combination of Bennett, Inoue, Yoseloff, and Kaminkow in order to make a slot machine game more entertaining and a more exciting experience as taught by Hamano.

### ***Response to Arguments***

Applicant's arguments with respect to claims **1-4, 6-11, 14-20, and 22-24** have been considered but are not persuasive.

Commencing on page 10 of their remarks the applicant concedes that the prior art of Kaminkow teaches both the vibration of the entire screen and limited portions thereof, however the applicant continues to characterizes the simulated motion of portion of the screen as not being representative of the claimed vibration feature and suggest that only the teachings of the entire screen would correlate to the claimed vibration feature. As Kaminkow clearly states, "However it should be appreciated that the present invention can be adapted so that certain portion of the screen do not move" (Kaminkow Col 5:25-32). These arguments do not fairly reflect the teachings of the Kaminkow reference and following therefrom cannot be persuasive.

Continuing on page 10 the applicant argues that the vibration feature provides a functional purpose. With regards to this argument it is first noted that apparatus type claim must distinguish over the prior art in terms of structure and not function making this argument moot with at least regards to the apparatus type claims presently pending. Further it is noted that the disclosed functionality associated with the vibration feature is not unique according to the applicant's own specification and in particular the passage on page 14 line 25 through page 15, lines 5 thereof in which the applicant equates the use of vibration to image alterations of shape, color patterns, and/or win lines for providing equivalent functionality. Notably such functionality has already been

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recognized by at least the prior art of Inoue with respect to this type of presentation as cited above. With regards to the applicant's interpretation of Kaminkow as only providing for the vibration of the entire screen, this allegation is not commensurate with the disclosure of Kaminkow specifically limiting the movement of select portion of the display (*Kaminkow* Col 5:25-32). Accordingly the applicant's arguments directly to the inclusion of the vibration feature and functionality provided therewith are non-persuasive because:

    this functionality is not fairly reflected the pending apparatus type claims;

    this feature is taught by the applicant as providing the same function through equivalence to elements provided for in the combination of references as applied;

    the proposition that the teachings of Kaminkow are only presented with reflection to the entire display and not a portion thereof is not fairly reflective of the Kaminkow reference; and/or

    there is no demonstration that the argued functionality is not provided for by the combination of reference as asserted in the rejections above.

On page 11 of the applicant remarks the applicant argues functional language of apparatus type claim 6.

While features of an apparatus may be recited either structurally or functionally, claims directed to an **apparatus must be distinguished from the prior art in terms of structure rather than function**. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate



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the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. (See Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987), In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971), In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959), and MPEP 2114).

The remainder of the applicant arguments are either directly addressed in the rejections as presented above or dependent on previously arguments redress in this section.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT MOSSER whose telephone number is (571)272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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